

REMARKS

By this amendment, Applicants have amended claims 12, 20, 23-26, 31, 35, 37, 40, and 42-43. As a result, claims 12-16, 20-27, and 31-43 are pending in this application. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the rejections and reserve the right to pursue the full scope of the subject matter of the original claims, or claims that are potentially broader in scope, in the current and/or a related patent application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, the Office rejects claim 41 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,134,568 (Tonkin). In order to maintain a proper rejection under 35 U.S.C. § 102, the Office must show that a single reference discloses each feature of the claimed invention. In particular, the Office must show that “[t]he identical invention... [is] shown in as complete detail as is contained in the... claim” to maintain a rejection under 35 U.S.C. § 102. See, e.g., MPEP § 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). To this extent, in order to anticipate the claimed invention, the reference must “disclose[] within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, No. 2007-1565, pp. 17-18 (Fed. Cir. 2008). Applicants respectfully submit that the Office fails to present such a showing.

For example, Applicants respectfully submit that Tonkin fails to disclose generating content for a display area that concurrently includes a preview area, a

navigation area, an estimate area, and a configuration area as claimed therein. In support of the rejection, the Office cites: col. 7, lines 11-46 of Tonkin, which discusses a main document editing window shown in FIG. 5B of Tonkin; and col. 12, line 23-col. 13, line 51 of Tonkin, which discusses a viewing window shown in FIGS. 8A-E, and a window for displaying document data shown in FIG. 9 of Tonkin. To this extent, the Office cites the use of three distinct windows in Tonkin as allegedly disclosing the display area of claim 41.

In contrast, the invention of claim 41 generates content for a display area of a graphical user interface that concurrently includes a preview area, a navigation area, an estimate area, and a configuration area. Tonkin's three distinct windows do not constitute a display area of a graphical user interface that concurrently includes the four areas of claim 41. To this extent, Applicants respectfully submit that the Office's citation of the three distinct windows shown and described in Tonkin fails to present a *prima facie* showing that Tonkin discloses not only all of the limitations claimed, but also all of the limitations arranged or combined in the same way as recited in claim 41.

As a result, Applicants respectfully request withdrawal of the rejection of claim 41 as allegedly being anticipated by Tonkin.

Furthermore, the Office rejects claims 37, 38, and 40 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,615,234 (Adamske).

With respect to claim 37, Applicants respectfully submit that Adamske fails, *inter alia*, to teach or suggest obtaining document information for a document on a server from system software, which is configured to enable a user of an application to request generation of a print file based on the document using the application, generate the print

file in response to the request without further user interaction, and initiate transmitting the print file to the server in response to the generation of the print file and without user-initiated interaction with the server, generating a unique identifier for the document on the server and transmitting the unique identifier for use by the system software, and obtaining a print file on the server from the system software executing on the client subsequent to obtaining the document information as claimed therein.

Interpreting Adamske only for the purposes of this response, Adamske generally discusses two embodiments for a system and method for delivering an electronic document over a network.

In the first embodiment, discussed from column 4, line 61 through column 6, line 23 of Adamske, a user uploads an electronic document from a client computer to a web server using a web browser or email. Adamske, col. 5, lines 15-16. The electronic document is then converted to a portable printable format on an application translation server. Adamske, col. 5, lines 18-19. In order to perform the conversion, "the application translation program [on the application translation server] houses the variety of client applications that users use to create electronic documents." Adamske, col. 5, lines 19-21. The converted printable electronic document is then transmitted to a web server, where it is processed to create web-viewable print preview files. Adamske, col. 5, line 64-col. 6, line 3. The user can use the client-side web browser to preview the document. Adamske, col. 6, lines 12-15.

In the second embodiment, discussed from column 6, lines 24-57 of Adamske, "the client computer includes a print driver program... that is executable to convert the electronic document and provide the print preview capability prior to uploading to the

web server.” Adamske, col. 6, lines 34-38. In particular, the print driver program creates a metafile from the electronic document, which provides a viewable representation of how the document will look upon printing. Adamske, col. 6, lines 46-49. Subsequently, the user “sends this metafile to [the application] translation server through web server and the conversion into a printable (e.g., PostScript) version is performed as previously described.” Adamske, col. 6, lines 49-52.

To this extent, contrary to both embodiments of Adamske, in which a printable version of a file is generated on an application translation server after a user sends a metafile to the application server, a print file is obtained on the server from system software executing on a client in claim 37.

Additionally, the invention provides system software configured to generate the print file on the client in response to a request generated by a user of the client using an application without further user interaction and initiate transmitting the print file from the client to the server in response to the generation of the print file and without user-initiated interaction with the server. In contrast, in Adamske, the print driver program first performs the print preview, and the user must subsequently send a metafile to the application translation server for conversion to the printable version.

Applicants note that the Office does not address that the system software is configured to generate a print file and initiate transmitting the print file from the client to the server without further user-initiated interaction after generation of the print file is requested in its rejection. In contrast, as discussed above, Adamske requires, *inter alia*, that the user send a metafile to the application translation server for conversion to the printable version.

In light of the above, Applicants respectfully request withdrawal of the rejections of claim 37, and claims 38, and 40, which depend therefrom, as allegedly being unpatentable over Adamske.

Furthermore, the Office rejects claims 12-16, 20-27, 31-36, 39, and 42 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske in view of Tonkin. Claim 43 is also indicated as being unpatentable over Adamske in view of Tonkin, apparently in error.

With respect to claim 12, Applicants submit that the Office fails, *inter alia*, to show that the proposed combination of Adamske and Tonkin teaches or suggests a method of previewing a document over a network that includes all the features claimed therein. For example, for reasons that should be clear from the discussion of Adamske above, Applicants submit that Adamske fails to teach or suggest providing the system software claimed therein. To this extent, the Office explicitly alleges that, in Adamske, “[t]he user... uploads the print file to the server.” Office Action, p. 6. Even if, *arguendo*, this interpretation of Adamske is accurate, this is in direct contrast to the invention of claim 12 in which the provided system software, in response to a request to remotely print the document and without user-initiated interaction with a server, generates a print file on the client based on the document, transmits the print file to the server in response to the generation of the print file, and prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file.

Additionally, Applicants submit that Tonkin fails to cure the deficiencies of Adamske discussed above. In particular, Tonkin provides a web page in which a user enters a source file that includes the content to be included in a document. Tonkin, FIG.

5B, ref. 312; col. 7, lines 13-17. The source file can be a PDF file or another format, which can be first converted to PDF format. Tonkin, col. 7, line 17-27. Subsequently, image(s) of the document are generated and displayed. Tonkin, col. 12, lines 23-34. To this extent, Tonkin also teaches that the user uses a web page to send a document to a server. In contrast, the provided system software of claim 12, in response to a request to remotely print the document and without user-initiated interaction with a server, generates a print file on the client based on the document, transmits the print file to the server in response to the generation of the print file, and prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file.

As a result, Applicants respectfully request withdrawal of the rejections of claim 12 and claims 13-16 and 32-34, which depend therefrom, as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 20, for reasons that should be obvious in view of the discussion of Adamske and Tonkin above, Applicants respectfully submit that the proposed combination of Adamske and Tonkin fails to teach or suggest a component configured to preview a document over a network by providing the system software claimed therein.

As a result, Applicants respectfully request withdrawal of the rejections of claim 20 and claims 21-23, which depend therefrom, as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 24, for reasons that should be obvious in view of the discussion of Adamske and Tonkin above, Applicants respectfully submit that the

proposed combination of Adamske and Tonkin fails to teach or suggest a component configured to print a document over a network by providing the system software claimed therein.

As a result, Applicants respectfully request withdrawal of the rejections of claim 24 and claims 25-27 and 35-36, which depend therefrom, as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 31, for reasons that should be obvious in view of the discussion of Adamske and Tonkin above, Applicants respectfully submit that the proposed combination of Adamske and Tonkin fails to teach or suggest program code for enabling a computer system to print a document by providing the system software claimed therein.

As a result, Applicants respectfully request withdrawal of the rejection of claim 31 as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 39, Applicants incorporate the arguments presented above with respect to claim 37 from which this claim depends. Additionally, Applicants submit that the proposed combination of Adamske with Tonkin fails to address the deficiencies of Adamske discussed above with respect to claim 37. As a result, Applicants respectfully request withdrawal of the rejection of claim 39 as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 42, for reasons that should be obvious in view of the discussion of Adamske and Tonkin above, Applicants respectfully submit that the proposed combination of Adamske and Tonkin fails to teach or suggest a computer program product for enabling a computer system to preview a document by generating

a print file on a client, transmitting the print file from the client to a server without user-initiated interaction with the server, and prompting the user to configure and preview a bound copy of the document as claimed therein.

As a result, Applicants respectfully request withdrawal of the rejection of claim 42 as allegedly being unpatentable over Adamske in view of Tonkin.

Furthermore, the Office rejects claim 43 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske in view of Tonkin further in view of Konica Minolta, "QMS Printing Notes for Windows Applications," published June 20, 1995 (KM). Applicants incorporate the arguments presented above with respect to claim 42 from which this claim depends. Additionally, Applicants submit that the proposed combination of Adamske and Tonkin with KM fails to address the deficiencies of the proposed combination of Adamske with Tonkin discussed above with respect to claim 42. As a result, Applicants respectfully request withdrawal of the rejection of claim 43.

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary and/or in a related patent application, either of which may seek to obtain protection for claims of a potentially broader scope.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

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